

Appl. No. 10/055,805
Response dated 9/8/2005
Reply to Office Action of 3/08/2005

REMARKS/ARGUMENTS

Claim Rejections 35 USC 112 1st

The Examiner rejects claims 1, 3-18, 20-35, 37-50, and 52 under 35 USC 112, first paragraph and argues that the specification does not reasonably provide enablement for use of player predicted outcomes in non-binary chance games or any number of players greater than one in a non-binary game. Applicant respectfully disagrees for at least the reasons stated herein.

The determination of the propriety of a rejection based upon the scope of a claim relative to the scope of the enablement involves two stages of inquiry. The first is to determine how broad the claim is with respect to the disclosure. The entire claim must be considered. This requires a determination as to exactly what subject matter is encompassed by the claims. See, e.g., *AK Steel Corp. v. Sollac*, 344 F.3d 1234, 1244, 68 USPQ2d 1280, 1287 (Fed. Cir. 2003). The examiner should determine what each claim recites and what the subject matter is when the claim is considered as a whole, not when its parts are analyzed individually. The second inquiry is to determine if one skilled in the art is enabled to make and use the entire scope of the claimed invention without undue experimentation. In order to make a rejection under 35 USC 112 1st, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. In *re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). According to *In re Bowen*, 492 F.2d 859, 862-63, 181 USPQ 48, 51 (CCPA 1974), the minimal requirement is for the examiner to give reasons for the uncertainty of the enablement. This standard is applicable even when there is no evidence in the record of operability without undue experimentation beyond the disclosed embodiments. See MPEP 2164.04.

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Applicant respectfully submits that the Examiner has not met the required burden. The Examiner concludes that an enablement issue exists stating among other things that "there is no related discussion in the specification regarding the claim "predicted outcome" with regards to the multi-player embodiment. Applicant respectfully disagrees and points the Examiner to paragraphs 0050 and 0051 of the present application in published form (US Publication No. 2003/0027629) which states:

[0050] The invention also contemplates an embodiment wherein the gaming engine may simulate multiple coin tosses. In this instance, more than two players can wager on the outcome of the random chance event. Thus multiple players can participate in the game. In order to being a first player is selected to be the "spinner." That player is responsible for initiating the random chance event (e.g. coin toss) and selects a "spinners bet." Each player can then wager on the outcome of the event. In one embodiment of the invention, the players each selects heads or tails and wait to see if their selection results in a win. The players abide by the rules of the game referred to as "TwoUp."

[0051] In accordance with another embodiment of the invention, the three players may participate. Each of the three players tosses a single coin, and the odd coin wins. In this embodiment, if all three players come up with the same result the toss is repeated until there is an oddman. This embodiment may also be adapted to incorporate any number of odd players where the player with the odd coin wins. In this embodiment the house can be represented as a Player, or it can be amongst three individuals, and the house continues to collect a commission from the winner. As is the case above each player must demonstrate an account balance large enough to cover the wager.

The aforementioned paragraphs and the other description provided in the detailed specification provide an adequate example of how a predicted outcome is handled in multi-player situations. The player with the odd result is determined to be the winner (see claim 1 which contains this limitation). In cases where there is more than one odd result the games

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iterates until an add result is achieved. As such Applicant respectfully requests that the rejection pursuant to 35 USC 112 , 1st paragraph be withdrawn.

Claim Rejections – 35 USC 112 2nd

The Examiner states that claims 1, 3-18, 20-35, 37-50 and 52 are rejected under 35 USC 112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. For at least the reasons stated herein Applicant respectfully disagrees.

The MPEP 2173.02 requires that the examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph, is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire.

In the present case the Examiner argues that the term “odd triality” fails to distinctly claim the invention. The claims as amended no longer use the term “odd triality”, but instead use the term “odd number of players.” Support for there being an odd number of players is present at paragraph 0051 of the published application cited above. Hence it is appropriate for the 35 USC 112, 2nd rejection to be withdrawn.

Claim Rejections – 35 USC 102

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Claims 1, 3-4, 7, 9, 18, 20-21, 24, 26, 35, 37, 39, and 41 were rejected under 35 USC 102 as being anticipated by Cummings. For at least the reasons stated herein Applicant respectfully disagrees that Cummings anticipates each and every element of the invention as it is presently claimed. Specifically Cummings does not describe an instance where a random number generator executes on a gaming engine separable from a gaming interface and where an odd number of players wagering on the predicted outcome a player with an odd minority result is to be determined as a winner in cases where there is a single one of said odd result from a set of results as is provided in claim 18. Moreover Cummings does not disclose a system that determines the winner of the odd number of players from the actual outcome and when the winner cannot be determined re-executes the random number generator to obtain a second actual outcome until a winner is determined.

Cummings also lacks and description or support for one player challenging another player to wager on a given random change event as set forth in new claim 53. For instance, Cummings does not have a mechanism for a first player initiating a challenge to a second player via a communication mechanism, obtain a predicted outcome from the second player and assign the first player to an alternative outcome. Moreover Cummings does not have a mechanism for determining a winner between the second player wagering on the predicted outcome and the first player wagering on the alternative outcome by determining whether the predicted outcome matches the actual outcome or the alternative outcome matches the actual outcome. Cummings lacks any of the aforementioned features and as such cannot be said to anticipate the claimed invention.

Claim Rejections – 35 USC 103

Claims 5-6, 8, 10-11, 13-17, 22-23, 25, 27-28, 30-34, 38, 40, 42-43 and 45-49 are rejected under 35 USC 103 as being unpatentable under Cummings et al. For at least the reasons

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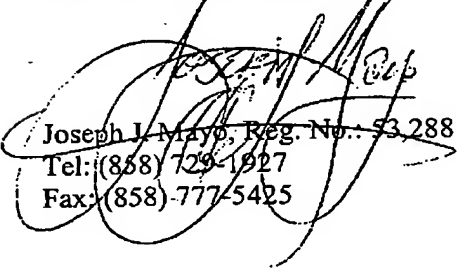
stated herein Applicant respectfully disagrees. Claims 5-6, 8, 10-11, 13-17, 22-23, 25, 27-28, 30-34, 38, 40, 42-43 and 45-49 are dependent claims which depend upon allowable base claims as set forth above. Hence for the reasons stated above with respect to the independent claims the Applicant respectfully submits that claims 5-6, 8, 10-11, 13-17, 22-23, 25, 27-28, 30-34, 38, 40, 42-43 and 45-49 be placed in condition for allowance.

Conclusion

For at least the reasons stated herein, Applicant respectfully submits that the amended claims and the new claims are in condition for allowance and hereby requests a timely Notice of Allowance be issued in this case.

If the Examiner differs in this conclusion, the Examiner is hereby requested to contact Applicant's representative for purposes of a telephone interview at the number listed below before any action (other than an allowance) is initiated. A formal outline for an interview will be submitted when the Examiner indicates to Applicant's representative that this present case is ready for review.

Respectfully submitted,
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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office on September 8, 2005 to 571-273-8300.


Joseph J. Mayo

September 8, 2005